

## REMARKS

In the Office Action mailed August 22, 2008 (hereinafter, "Office Action"), claims 5, 6, 8-11 and 15-22 were objected to. Claims 1-3, 12-14 and 23 were rejected under 35 U.S.C. § 102(b). Claims 4 and 7 were rejected under 35 U.S.C. § 103(a). By this paper, claims 1, 4, 7, 11, 12, 14, 15, 18, 22 and 23 are being amended. New claims 24 and 25 are being added.

Applicants respectfully respond to the Office Action.

### **I. Objection to Claims 5, 6, 8-11 and 15-22**

Claims 5, 6, 8-11 and 15-22 were objected to based on MPEP 608.01(n). The Examiner stated that the claims at issue were "in improper form because a multiple dependent claim should refer to other claims in the alternative only and cannot depend from any other multiple dependent claim." (Office Action, page 2.) The claims have been amended, as appropriate, so that none of the claims depend from a multiple dependent claim. Also, the multiple dependent claims in the present application do refer to other claims in the alternative only. Accordingly, Applicants respectfully request that the objection to claims 5, 6, 8-11 and 15-22 be withdrawn.

### **II. Claims 1-3, 12-14 and 23 Rejected Under 35 U.S.C. § 102(b)**

Claims 1-3, 12-14 and 23 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent Application Publication No. 2002/0041292 to Son et al. (hereinafter, "Son"). Applicants respectfully request reconsideration in view of the above claim amendments and the following remarks.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP § 2131 (citing Verdegaal Bros. v. Union Oil Co. of California, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). "The identical invention must be shown in as complete detail as is contained in the ... claim." Id. (citing Richardson v. Suzuki Motor Co., 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). In addition, "the reference must be enabling and describe the applicant's claimed invention sufficiently to have placed it in possession of a person of ordinary skill in the field of the invention." In re Paulsen, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994).

Claim 1, as amended above, recites:

A method of displaying a subset of a plurality of user interface elements in a user interface, the method comprising the steps of:

- (i) determining the size of the subset of plurality of UI elements that can be displayed within the user interface;
- (ii) determining a plurality of UI elements that may be selected for display within the user interface;
- (iii) selecting the subset of UI elements from the plurality of UI elements determined in step (ii); and
- (iv) displaying the subset of UI elements selected in step (iii) within the user interface;

wherein as the selected subset of UI elements changes, the UI elements no longer on display are discarded and the UI elements on display are loaded into memory.

Support for the amendments made to claim 1 may be found in at least the following portions of Applicants' specification: page 12, lines 9-12; and page 13, lines 12-15.

Son describes a "method of displaying a list of menus on a screen of a mobile telephone." (Son, abstract.) Figures 4A through 4C of Son show "displays of a mobile telephone." (Son, paragraph [0024].) Figures 4A through 4C of Son are reproduced below.

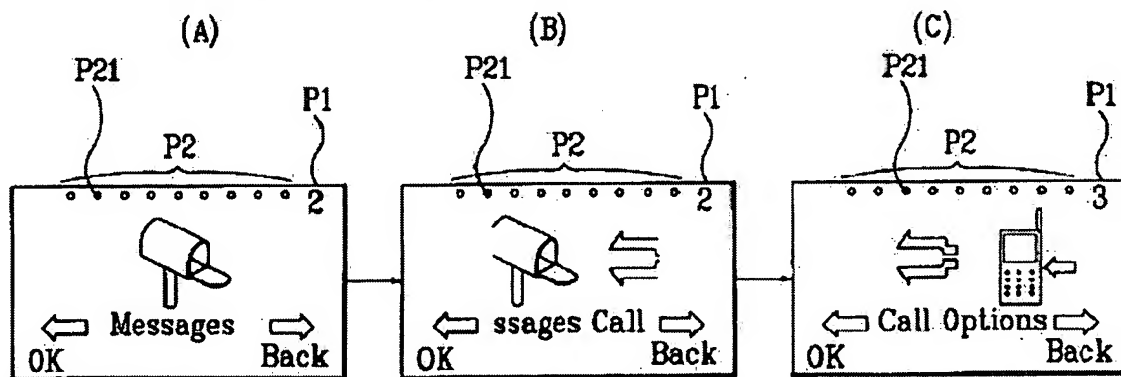


Figure 4A of Son shows "a first display ... illustrating a Message menu." Figure 4B of Son shows "an intermediate display ... showing both parts of the Messages menu and its Call Option menu." Figure 4C of Son shows "a third display entirely showing the Call Option menu." Son states that a "telephone user must scroll in order to move from FIG. A to FIG. C or from FIG. C to FIG. A by pressing a proper key." (Son, paragraph [0024].)

The Examiner asserts that this part of Son discloses the subject matter of claim 1. It appears that the Examiner is interpreting the Messages menu and the Call Options menu to be the "plurality of UI elements" in claim 1. It also appears that the Examiner is interpreting either the

Messages menu when displayed alone (as in Figure 4A) or the Call Options menu when displayed alone (as in Figure 4C) to be the “subset of UI elements” in claim 1. (See Office Action, pages 2-3.)

Even assuming *arguendo* that such an interpretation is correct, Son still does not disclose all of the subject matter of amended claim 1. In particular, Son does not disclose that “as the selected subset of UI elements changes, the UI elements no longer on display are discarded and the UI elements on display are loaded into memory,” as recited in amended claim 1.

In the Office Action, the Examiner refers to paragraph [0024] of Son. (Office Action, page 3.) This part of Son describes the mobile telephone displays shown above. In addition to what was discussed above, Son also indicates that “[e]ach display ... includes a top page number P1 indicating the order number of a top menu currently being displayed, a plurality of boxes P2 indicating the total number of the existing top menus, and a blinking box P21 indicating which top menu among all the existing top menus is being currently being displayed.” (Son, paragraph [0024].) However, the top page number P1, boxes P2 and blinking box P21 clearly do not disclose anything about which “UI elements ... are discarded” and which “UI elements ... are loaded into memory,” which is the subject matter at issue in amended claim 1.

The Examiner also refers to paragraph [0025] of Son. (Office Action, page 3.) This part of Son describes how a user that is viewing the Messages menu (Figure 4A) may “press[] down a navigation key or enter[] a top menu number in order to move to ... the intermediate figure” (Figure 4B) which shows half of the Messages menu and half of the Call Options menu. The user may “press[] down the navigation key or enter[] the top menu number again to move to the next menu,” which shows the Call Options menu (Figure 4C). However, this part of Son simply describes how the user may scroll from one menu to the next. It does not say anything about which “UI elements ... are discarded” and which “UI elements ... are loaded into memory,” which is the subject matter at issue in amended claim 1.

The Examiner also refers to paragraph [0031] of Son. (Office Action, page 3.) This part of Son refers to “a numerical and graphical menu indicator indicative of the current menu location in a menu tree,” “a cursor scrolling up and down for selecting a desired item in a friendly manner,” and “a numerical and graphical presentation indicative of the current cursor location in a menu tree.” Thus, paragraph [0031] of Son relates to a “menu tree” and various “numerical and graphical” indicators. However, there is nothing about a “menu tree” or

“numerical and graphical” indicators that could reasonably be interpreted as disclosing anything about which “UI elements ... are discarded” and which “UI elements ... are loaded into memory,” as recited in amended claim 1.

For at least the foregoing reasons, Applicants respectfully submit that amended claim 1 is allowable. Accordingly, Applicants respectfully request that the rejection of amended claim 1 be withdrawn.

Claims 2-3 depend from claim 1. Claims 12 and 23 have been amended to include subject matter that is similar to the subject matter discussed above in relation to claim 1. Claims 13-14 depend from claim 12. Accordingly, Applicants respectfully request that the rejection of claims 2-3, 12-14 and 23 be withdrawn for at least the same reasons as those presented above in relation to claim 1.

### **III. Claims 4 and 7 Rejected Under 35 U.S.C. § 103(a)**

Claims 4 and 7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Son in view of European Patent Application Publication No. EP1193590 to Kennedy et al. (hereinafter, “Kennedy”). Applicants respectfully request reconsideration in view of the above claim amendments and the following remarks.

The factual inquiries that are relevant in the determination of obviousness are determining the scope and contents of the prior art, ascertaining the differences between the prior art and the claims in issue, resolving the level of ordinary skill in the art, and evaluating evidence of secondary consideration. KSR Int’l Co. v. Teleflex Inc., 550 U.S. \_\_\_, 2007 U.S. LEXIS 4745, at \*\*4-5 (2007) (citing Graham v. John Deere Co. of Kansas City, 383 U.S. 1, 17-18 (1966)). As the Board of Patent Appeals and Interferences has recently confirmed, “obviousness requires a suggestion of all limitations in a claim.” In re Wada and Murphy, Appeal 2007-3733 (citing CFMT, Inc. v. Yieldup Intern. Corp., 349 F.3d 1333, 1342 (Fed. Cir. 2003)). Moreover, the analysis in support of an obviousness rejection “should be made explicit.” KSR, 2007 U.S. LEXIS 4745, at \*\*37. “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” Id. (citing In re Kahn, 441 F.3d 977, 988 (Fed. Cir. 2006)).

As discussed above, Son does not disclose that “as the selected subset of UI elements changes, the UI elements no longer on display are discarded and the UI elements on display are loaded into memory,” as recited in amended claim 1. Son also does not suggest this claimed subject matter. Kennedy does not make up for the deficiencies of Son. Applicants cannot find any portion of Kennedy which discloses or suggests the claimed subject matter at issue.

Claims 4 and 7 depend from claim 1. Accordingly, Applicants respectfully request that the rejection of claims 4 and 7 be withdrawn for at least the same reasons as those presented above in relation to claim 1.

**IV. New Claims 24 and 25**

New claims 24 and 25 are being added. New claims 24 and 25 include subject matter that is similar to the subject matter discussed above in relation to claim 1. Accordingly, new claims 24 and 25 are allowable for at least the same reasons as those presented above in relation to claim 1.

**Conclusion**

In light of the amendments contained herein, Applicants submit that the application is in condition for allowance, for which early action is requested.

Please charge any fees or overpayments that may be due with this response to Deposit Account No. 17-0026.

Respectfully submitted,

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